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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,862	02/04/2002	Nick Vicars-Harris	MSI-892US	5137

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,862

Applicant(s)

VICARS-HARRIS, NICK

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-28 is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Remarks

1. The Amendment filed on September 22, 2004 has been received and entered. Claims 1-28 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8, and 15-22 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, directed towards an data structure.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". "Rubber Tip Pencil Co. V. Howard", 20 Wall.498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work "Gottschalk v. Benson", 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter "Parker v. Flook", 197 USPQ 193, 201 (S Ct 1978).

Database Structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. Applicant's claims are not within any of the statutory classes. "A database structure" should define structural and functional interrelationships between data structures or functional parts and a computer system which permit the data functions to be realized, and is statutory.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Independent claims 9, 15, and 21, the phrase "can be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

There are multiple occurrences of the recitation "can be" throughout the claims cited.

Claims 10-14, 16-20, and 22, respectively, are dependent on the claims listed above and therefore carry the same deficiency.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 6-8, and 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Yogeshwar et al. (U.S. Pub. No. 2004/0096110 A1).

As to claim 1, Yogeshwar et al. discloses a method comprising:

providing compressed data that has been compressed using a first encoder having an associated first decoder that can be used to uncompress the compressed data (See page 5, paragraphs 0073-0075);

providing the compressed data to at least one second decoder that is different from the first decoder and which is involved in actually causing the compressed data to be compressed (See pages 7-8, paragraphs 0105-0106);

uncompressing the compressed data to provide uncompressed data (See page 11, paragraphs 0150-0163); and

operating on the uncompressed data to provide modified uncompressed data (See pages 10-11, paragraphs 0142-0146).

As to claim 2, Yogeshwar et al. discloses further comprising rendering the modified uncompressed data using a rendering application (See page 11, paragraphs 0150-0163).

As to claim 3, Yogeshwar et al. discloses wherein said providing the compressed data to the second decoder comprises searching for an ID tag associated with the compressed data and which corresponds to the second decoder (See page 8, paragraphs 0107-0108).

As to claim 4, Yogeshwar et al. discloses wherein the second decoder comprises a wrapper for the first decoder, said uncompressing comprising providing the compressed data to the wrapped first decoder (See page 5, paragraphs 0073-0075, also see page 13, column 1, lines 12-67, and see page 13, column 2, lines 1-51).

As to claim 6, Yogeshwar et al. discloses wherein the compressed data comprises audio data (See page 8, paragraph 0116).

As to claim 7, Yogeshwar et al. discloses wherein the compressed data comprises video data (See page 8, paragraph 0116).

As to claim 8, Yogeshwar et al. discloses wherein the compressed data comprises both audio data and video data (See page 8, paragraph 0116).

As to claim 15, Yogeshwar et al. discloses a method comprising:
receiving a file comprising compressed data and information associated with an encoder that compressed source data corresponding to the compressed data, said information being configured for use in locating a first decoder that corresponds to the encoder and which can be used to uncompress the compressed data (See page 8, paragraphs 0108-0110, also see page 5, paragraphs 0075-0077, and see page 13, column 2, lines 30-51);
searching for the information (See page 8, paragraph 0116, also see page 10, paragraph 0140); and

replacing the information with different information that is associated with a second decoder that is different from the first decoder and which can be used, at least in part, to uncompress the compressed data (See page 10, paragraphs 0140-0142, wherein “replacing” reads on “conversion”).

As to claim 16, Yogeshwar et al. discloses wherein both said information and said different information comprise respective ID tags (See page 8, paragraph 0108, also see pages 10-11, paragraphs 0146-0148).

As to claim 17, Yogeshwar et al. discloses wherein said compressed data comprises audio data (See page 2, paragraph 0015).

As to claim 18, Yogeshwar et al. discloses wherein said compressed data comprises video data (See page 2, paragraph 0015).

As to claim 19, Yogeshwar et al. discloses wherein said compressed data comprises both audio data and video data (See page 2, paragraph 0015).

As to claim 20, Yogeshwar et al. discloses wherein the second decoder comprises a wrapper for the first decoder (See page 13, column 1, lines 23-39).

As to claim 21, Yogeshwar et al. discloses a software application comprising:

an encoding application (See page 8, paragraph 0107) configured to:
receive a file comprising compressed data and information associated with an encoder that compressed source data corresponding to the compressed data, said information being configured for use in locating a first decoder that corresponds to the encoder and which can be used to uncompress the compressed data (See page 8, paragraphs 0108-0110, also see page 5, paragraphs 0075-0077, and see page 13, column 2, lines 30-51);

search for the information (See page 8, paragraph 0116, also see page 10, paragraph 0140); and

replace the information with different information that is associated with a second decoder that is different from the first decoder and which can be used, at least in part, to uncompress the compressed data See page 10, paragraphs 0140-0142, wherein “replacing” reads on “conversion”).

As to claim 22, Yogeshwar et al. discloses wherein the second decoder comprises a wrapper for the first decoder (See page 13, column 1, lines 12-37).

Allowable Subject Matter

8. Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

9. The following is a statement of reasons for allowance:

The prior art of record (Yogeshwar et al. -U.S. Pub. No. 2004/0096110 A1) does not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), wherein the second decoder comprises a wrapper for the first decoder, said decompressing comprising providing the compressed data to the wrapped first decoder so that the wrapped first decoder can uncompress the compressed data, and further comprising providing the modified uncompressed data to the second decoder so that the second decoder can provide the modified uncompressed data to a rendering application for rendering, as claimed in dependent claim 5.

10. Claims 9-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The prior art of record (Yogeshwar et al. -U.S. Pub. No. 2004/0096110 A1) does not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), searching for said at least one ID tag to identify the second decoder; providing the compressed file to the second decoder so that the compressed file can be uncompressed; using the second decoder, providing the compressed file to the first decoder, as claimed in independent claim 9.

Claims 10-14 are objected to because they are dependent from objected to independent claim 9.

Reasons for Allowance

11. Claims 23-28 are allowed over the prior art made of record.

12. The following is a statement of reasons for allowance:

The prior art of record (Yogeshwar et al. -U.S. Pub. No. 2004/0096110 A1) does not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim), provide the compressed source data to the first decoder so that the compressed source data can be uncompressed; receive back modified source data that has been modified in some way so that the modified source data is different from the original source data, as claimed in independent claim 23.

Claims 24-28 are allowed over the prior art made of record, because it is dependent from the allowed independent claim 23.

Response to Arguments

13. Applicant's arguments filed on September 22, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument on pages 11, 13, and 17 that "Yogeshwar et al. does not teach anywhere of providing compressed data to at least one second decoder that is different from the first decoder and which is involved in actually causing the compressed data to be uncompressed" is acknowledged but is not deemed to be persuasive.

The Examiner points to Yogeshwar et al. page 13, column 2, lines 11-30, wherein the reference teaches plurality of decoders which is deemed to be "different". Yogeshwar et al. further teaches on page 10, paragraph 0144, "enabled decoders" as output devices for rendered data indicating more than one decoder, which are different.

In response to applicant's arguments on pages 13, and 17-18 that "Yogeshwar et al. teaches away from the current invention" is respectfully considered but is not deemed to be persuasive.

The Examiner's response is that Yogeshwar et al. clearly states the limitation in the reference cited and whether Yogeshwar et al. uses the technology in the same manner as the applicant or not is not the intention here but instead the fact that Yogeshwar et al. teaches such method to exist in itself reads on the limitation of the claim.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
February 3, 2005


CHARLES RONES
PRIMARY EXAMINER